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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,597	04/03/2000	Kenichiro Sato	Q58614	4840

7590 03/19/2002

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EXAMINER

ASHTON, ROSEMARY E

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/19/2002

124

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/541,597

Applicant(s)

SATO ET AL.

Examiner

Rosemary E. Ashton

Art Unit

1752

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED **FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may **only** be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on December 20, 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-3.Claim(s) objected to: 14.Claim(s) rejected: 4-13.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

 **ROSEMARY ASHTON**
PRIMARY EXAMINER

Rosemary E. Ashton
Primary Examiner
Art Unit: 1752

Continuation of 5. does NOT place the application in condition for allowance because: The Declaration filed December 20, 2001 does not provide evidence of unexpected results for the following reasons.

The compositions in Table 1, which applicant states are directed to claims 4-8, do not have the same resin and thus the compositions can not be compared. Applicant argues the inventive examples showing an unexpected decrease in defects "are obtained by the combination of claimed resin and the claimed solvent". Claims 4-8 do not read on a solvent and no solvent is included in Table 1. If applicant meant to say surface active agent, rather than solvent, the results are still not unexpected because the purpose of including a surface active agent in the composition is to aid in the coating of the composition, thus improvements in the properties of the composition are expected.

The compositions in Table 2, which applicant states are directed to claims 9-13, again have different resins. Applicant argues the solvent mixture S1/S3 is within the scope of the present invention, however, this is not the case. Solvent S1, as defined on page 145 of the specification is propylene glycol monomethyl ether acetate. Claim 9 does not read on this solvent but propylene glycol monoalkyl ether. Additionally, the results from the solvent mixture S2/S3 can not be used because solvent S2 is propylene glycol monomethyl ether propionate which also is not claimed in claim 9. Additionally, the solvents in Table 2 of the Declaration are not commensurate in scope with the claimed solvents in claim 9 which read on propylene glycol monoalkyl ether wherein the alkyl group is not defined.